

Serial No. 10/010,883
Art Unit: 1713

REMARKS

The Examiner has required election between species Ia and Ib, and between IIa and IIb. Since an oral provisional election has already been made, Applicants affirm this election with traverse, i.e. species Ib and species IIb.

Applicants traverse on the ground that the claims as amended which are generic to the above species are in fact patentable over the cited art for the reasons given below.

The claims readable on the above elected species are claims 16, 18-20, 24-31.

In paragraph 6 the Examiner has indicated that a reference to the prior application should be inserted on page 1 of the application, together with its current status. The specification has been so amended.

In paragraphs 7-9 of the Action, the Examiner contends that there is no enablement for a particular reaction product, or for use of the reaction product. The Examiner further contends that there are a multitude of products produced by at least one A) and at least one B).

The Examiner's attention is first of all directed to the parent patent, directed to composition claims containing the subject matter and language objected to by the Examiner. The independent claim in the parent patent is reproduced below for ready reference:

"An emulsion polymer composition containing an emulsion stabilizing effective quantity of a product consisting essentially of the base catalyzed reaction of

A) at least one compound of formula I



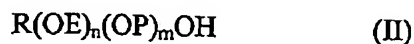
wherein one X group is a halogen atom and two X groups represent an epoxy oxygen atom, which is attached to two adjacent carbon atoms in the

Serial No. 10/010,883

Art Unit: 1713

R¹ group to form an epoxy group, and R¹ is an alkanetriyl group containing from 3 to 10 carbon atoms; and

B) at least one compound of formula II



wherein R is a saturated or unsaturated organic group having from 3 to 22 carbon atoms, n is a number of from 1 to 50, m is a number of from 0 to 10, EO represents an ethyleneoxy group, and OP represents a propyleneoxy group;

wherein the mole ration of components A) and B) is from about 0.60:1 to about 2:1."

Secondly, the Examiner's attention is directed to the operating Examples in the application. See e.g. Example 1 where ethoxylated decyl alcohol is reacted with epichlorohydrin and the resulting liquid product isolated from the reaction mixture. The exact composition of the liquid product is irrelevant since Applicants are not claiming the product or mixture of products by chemical structure, but rather by product-by-process claims. Such claims are of course both well-known and acceptable under patent law and practice.

See also Examples 2 and 3 where different alkoxylated alcohols are used and the resulting products isolated.

See further Examples 10-17 where all compositions containing the reaction product of Example 1 "very significantly enhanced the mechanical stability of the latex." (Page 24, lines 1-3).

With respect to Examples 1-3, Applicants have given actual operating examples for the preparation of several reaction products of the invention, with clear methods for their preparation

Serial No. 10/010,883

Art Unit: 1713

and isolation from their reaction mixtures. Whether or not a single component A) and component B) or two or more of one or both are used in the reaction will not affect the process nor the utility of the resulting product mixture.

In paragraph no. 11 of the Action, the Examiner has rejected claims 16, 18-20 and 24-31 under 35 U.S.C. 103(a) as being unpatentable over Kato in combination with Nakamura et al.

It should be noted that independent claims 16 and 26 have been amended to make it clear that the products used in the method of the invention consist essentially of components A) and B).

With respect first to the Kato reference, as noted by the Examiner, Kato does not disclose the present reaction products nor any method for their use as stabilizers for emulsion polymer compositions, i.e. Kato clearly does not disclose, suggest, or otherwise render obvious the presently claimed invention.

It is, of course, understood that the rejection is not over the Kato reference alone, but rather over Kato in combination with Nakamura.

The Examiner noted that Nakamura teaches a wetting agent/emulsifier/surface agent comprising the reaction product of one mole of epihalohydrin per mole of a polyalkoxylated alcohol. However, the actual wetting agent/emulsifier/surface agent is a much more complex reaction product, i.e. the reaction product of an epihalohydrin and a polyalkoxylated alcohol is only an intermediate, being further reacted with an alkyl amine, followed by reaction with an acrylic acid lower alcohol ester followed by hydrolysis and neutralization, resulting in the complex compound shown in the PATENT ABSTRACTS OF JAPAN.

The present amendments to the independent claims exclude such complex compounds.

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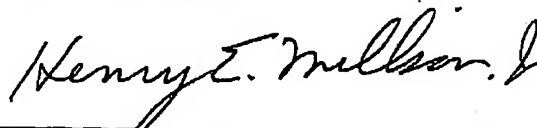
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Serial No. 10/010,883
Art Unit: 1713

Hence, even if Nakamura is combined with Kato, which it is submitted can only be done using hindsight, the present invention as set forth in the amended claims still cannot be obtained.

Accordingly, allowance of claims 16, 18-20 and 24-31, as well as restricted claims 17, 21-23, 32 and 33 is respectfully solicited.

Respectfully submitted,



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